Appl. No. 09/394,590
Reply to Office action of February 10, 2003

Attorney Docket No. 26530.3 / IDR-341
Customer No. 27683

REMARKS

Claims 1-42 are pending in the application. Claims 1, 12, 23, 34, and 40 have been amended, and claims 43 - 45 have been cancelled. Support for the amended material and the material of the added claims can be found in the original specification, for example, on page 2, lines 20-24; page 4, lines 17-24; page 6, line 13 – page 7, line 2; and page 7, lines 6-12.

The Applicant wishes to thank the Examiner for participating in a telephone interview on May 6, 2004. Amendments substantially similar to the proposed amendments discussed with the Examiner are included in this Response. During the interview the Examiner indicated that the proposed amendments appeared to overcome the cited references, although further searching and supervisory review would be necessary.

Rejections under 35 U.S.C. 103

Claims 1-42 stand rejected under § 103(a) as being unpatentable over U.S. Patent No. 6,289,378 to Meyer et al. ("Meyer") in view of U.S. Patent No. 6,327,608 to Dillingham ("Dillingham"), and further in view of U.S. Patent No. 6,351,748 to Deen et al. ("Deen"). Applicant traverses this rejection on the grounds that these references are defective in establishing a prima facie case of obviousness with respect to the rejected claims as amended.

As the PTO provides in MPEP §2143, "[t]o establish a prima facie case of obviousness, . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, under MPEP §2142, "[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness." It is submitted that the Office action does not factually support a prima facie case of obviousness for the following, mutually exclusive, reasons.

1. Cited References Do Not Teach the Claimed Subject Matter.

Applicant respectfully submits that the cited references do not teach the claimed subject

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matter. For example, independent claim 1, as amended, recites, "administering user rights to the first network object using the Internet authoring, collaboration and versioning protocol, wherein the administration of the user rights is allowed without requiring *client software*, related to the *network directory service*, installed on a user workstation" and "accessing the *network administration functions of the network directory service* using the Internet authoring, collaboration and versioning protocol." By contrast, Meyer requires the installation and use of an "agent" on each client computer, wherein the client computer is accessed when a "web browser makes a request to the agent" (col. 3, line 35-50). Then, "the agent preferably executes a Common Gateway Interface (CGI) program which pulls selected data from the operating system of the computer" (col. 3, line 54-57). Thus, the primary reference, Meyer, specifically requires an agent to perform operations, whereas claim 1 precludes the execution of such software.

Likewise, Dillingham teaches, "a user interface (UI) presented at a client" wherein "[t]he UI might be stored locally at the client, or downloaded on demand from the server" (col. 2, lines 29-37). "Using the client UI, the remote administrator can view the directory data, navigate the data, set properties for the listed files or folders, add or rearrange directories, delete or move files, or perform other general administration tasks" (abstract). Claim 1, in contrast, precludes client software related to the network directory service installed on a user workstation.

The Deen reference fails to remedy the deficiencies of Meyer and Dillingham, as the cited text fails to teach or suggest "accessing the network administration functions of *the network directory service* using the Internet authoring, collaboration and versioning protocol." Although not cited in reference to claim 1, the combination of U.S. Patent No. 6,195,097 to Shrader et al. ("Shrader") likewise fails to remedy the deficiencies of Meyer, Dillingham, and Deen. Whereas claim 1, for example, recites, "the protocol allows *a user* to perform remote web content authoring and user rights administration operations," Shrader, by contrast is directed toward the tasks of *network administrators*. For example, an "object of this invention is to. . .enable[s] network administrators to easily retrieve information on a DCE cell and execute management

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actions. . ." Thus, the Applicant's invention creates efficiencies which Shrader does not anticipate.

Accordingly, the cited references, taken either singly or in combination, fail to teach or suggest all the limitations of claim 1 as required by MPEP § 2143, and the claim is allowable for at least this reason. Claims 2-11 depend from and further limit claim 1 and are allowable as well for at least the same reason as claim 1.

Claims 12, 23, 34, and 40 each contain a limitation that is similar to that described above with respect to claim 1, and are allowable for at least the same reason as claim 1. Claims 13-22, 24-33, 35-39, and 41-42 depend from and further limit their respective independent claim and are allowable for at least this reason as well.

2. *Prior Art That Teaches Away From the Claimed Invention Cannot Be Used to Establish Obviousness.*

In the present case the Meyer and Dillingham references, by providing an agent and a UI stored locally at the client, respectively, are directed to a system in which dedicated client-side software is required. Thus, this system clearly teaches away from independent claims 1, 12, 23, 34, and 40.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of prima facie obviousness, it is clear that the initial burden of factually supporting any prima facie conclusion of obviousness has not been met.

3. *The References Are Not Properly Combinable if Their Intended Function is Destroyed.*

It is clear that the Meyer and Dillingham references are not properly combinable with Deen since, if combined, their intended function is destroyed. More particularly, if the Deen patent were to include the client-side software, as required by the rejection, it would be rendered inoperable for its intended purpose because the efficiency of managing "[b]ig web sites [which] often collect information from people across an organization, and sometimes across different

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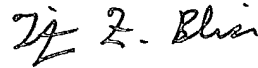Attorney Docket No. 26530.3 / IDR-341
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organizations" would be destroyed. Thus, since this modification of the Deen patent clearly destroys the purpose or function of the invention disclosed in the patent, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Thus, for this mutually exclusive reason, a prima facie case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Conclusion

It is respectfully submitted that claims 1-42 are in condition for allowance. Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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This paper and fee are being deposited with the U.S. Postal Service Express Mail Post Office to Addressee service under 37 CFR §1.10 on the date indicated above and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Gayle Conner

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